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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,093	02/26/2002	Jeffrey J. Shea	10557/266546	5422
30559	7590	07/13/2004	EXAMINER	
CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/083,093

Applicant(s)

SHEA ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 13-18 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 13-18 and 25-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10, 13-18 and 25-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dye et al. (US 6,120,546 or '546) in view of Farris et al. (US 6,152,927 or '927) and Khalili (US 6,228,121 or '121).

'546 discloses an implantable prosthesis 10 with screw holes 36 extending from a first surface 16 to a second surface 14 wherein a section of the hole at the second surface has a smaller diameter than a section of the hole at the first surface (Fig. 3, col. 1, lines 9-13 and col. 6, lines 58-65).

'546 also discloses that portion 40 of the screw hole can be a conical portion to receive a spherically shaped insertion member or screw for congruent or intimate contact inherently providing a fluid tight seal (col. 7, lines 13-31).

'546 does not disclose a screw hole having a proximal taper section at the first surface.

'546 also does not disclose a type of screw having a rounded non-frustoconical contact surface.

'927 teaches screw holes 34 in an implantable member wherein the proximal section of screw hole 34 has a flared or "tapered" recess 79 to facilitate insertion of a screw (Figs. 7, 9 and 13 and col. 9, lines 47-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a proximal flared recess in the holes 36 of '546 receiving screws, as taught by '927, to facilitate insertion of screws.

'121 teaches a type of insertion member or screw (108 and 110) having a rounded or spherical contact surface that mates with a screw hole wall 114 at a range of angles to provide access to desired regions of bone (col. 3, lines 28-33 and lines 61-67 and col. 4, lines 1-31).

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Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a screw, such as the type taught by Khalili, in a screw hole of the combination of '546 and '927, to allow for positioning of the screw at a range of angles to provide access to desired regions of bone.

Regarding claim 26, '546 discloses that the shell of '546 can be used in a well-known total hip joint prosthesis that includes an acetabular shell, an associated bearing liner and a femoral stem and an associated spherical head (col. 5, lines 60-67 and col. 6, lines 1-14).

The method steps of claims 27-38 are performed during normal use of an implantable prosthesis of the combination of '546, '927 and '121 for total hip arthroplasty.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-8, 10, 13-18, 25-26 and 27-38 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*  
July 8, 2004

  
EDUARDO C. ROBERT  
PRIMARY EXAMINER